

REMARKS

At the time of the Office Action dated May 27, 2004, claims 1-23 were pending, all of which stand rejected.

In this Amendment, claims 1, 3, 4, 6, 7, 11, 12, 14, 16, 18, 20, 22 and 23 have been amended and claims 2, 5, 13, 15, 17 and 19 have been canceled. Care has been exercised to avoid the introduction of new matter. Specifically, claims 1, 4, 12, 16 and 18 have been amended to include the limitations recited in claims 2, 5, 13, 17 and 19, respectively. Claim 18 has also been amended to claim a computer readable medium including a program to obviate a non-statutory subject matter issue. Claims 3, 6, 7, 11, 14, 20, 22 and 23 have been amended to improve wording. In addition, the specification has also been amended to improve wording.

Specification and Claim Objections.

In paragraphs 1 and 2 of the Office Action, the Examiner advised correcting informalities in the specification and claims. In response, Applicant has amended the specification and claims, as attached, to obviate those issues. Therefore, withdrawal of the objections to the specification and claims is respectfully solicited.

Claims 3, 14, 18-20 and 23 have been rejected under 35 U.S.C. §112, second paragraph.

In paragraph 4 of the Office Action, the Examiner pointed out that claims 3, 14, 20 and 23 are indefinite in that the claims never clearly identify what is being judged by the storage place judging means, and claims 18 and 19 include an antecedent basis issue. In response, Applicant has amended claims 3, 14, 18, 20 and 23 to obviate those issues, as attached. It is noted that the

rejection of claim 19 has been rendered moot by cancellation of the claim. Accordingly, Applicant respectfully solicits withdrawal of the rejection of claims 3, 14, 18-20 and 23.

Claims 18 and 19 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Examiner pointed out that the claims recite purely functional descriptive material, which is non-statutory. It is noted that the rejection of claim 19 has been rendered moot by cancellation of the claim.

In response, Applicant has amended claim 18 to claim a computer readable medium bearing a program for management of image data, as attached. Accordingly, withdrawal of the rejection of claim 18 is respectfully solicited.

Claims 1-7, 11-20, 22 and 23 have been rejected under 35 U.S.C. §102(e) as being anticipated by Schwab.

In the statement of the rejection, the Examiner asserted that Schwab discloses a secure digital interactive system identically corresponding to what is claimed.

It is established that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Based on the above legal tenet, Applicant submits that Schwab does not disclose an image management system, an image management terminal, an image management method and a computer readable medium including all the limitations recited in the claims, as amended. It is noted that rejection of claims 2, 5, 13, 15, 17 and 19 has been rendered moot by cancellation of those claims. As mentioned above, the limitations recited in claims 2, 5, 13, 17 and 19 have been added to corresponding independent claims 1, 4, 12, 16 and 18, respectively.

Claims 1, 12, 16 and 18.

Applicant stresses that Schwab does not disclose “sending said image data and said management information stored in said image management terminals to said image management server according to instructions from a user and sharing attribute information indicating whether said image data corresponding to said management information provided in advance in said management information should be sent to said image management server,” as recited in claims 1, 12, 16 and 18. Specifically, the reference does not disclose using the “sharing attribute information” for sending image data and management information from the image management terminals to the image management server.

With respect to claim 2 (regarding the limitations added to claims 1, 12, 16 and 18), the Examiner asserted as follows:

Schwab teaches making a determination about whether to list an image on the central server (col. 4 lines 9-17) or keep it within the local database (i.e. not share it). If the image in Schwab is not shared, then communication with the central database is cut off (col. 4 lines 15-16). Schwab further discloses that a communication connection (col. 6 lines 50-51) between the terminal and server is accessed with a password (col. 6 lines 39-41), which links “the files themselves with the password” via file header information. Consequently, we can conclude that this password information associated with individual images is analogous to the sharing attribute information recited in the claim. See the fourth full paragraph on page 4 of the Office Action.

In response, Applicant submits that Schwab's password contained in a file header is different from the claimed sharing attribute information. In addition, image data is not sent to a server according to that password in Schwab. In Schwab, a destination to which a password contained in a file is linked, is described as follows: "so as to link the files themselves with the password character sequence contained inside a hardware security key" (column 6, lines 39-41). In other words, in Schwab, the password is a hardware security key stored in a "dongle" to be connected to a PC, for instance. Therefore, the reference merely discloses that the hardware security key is (1) utilized for connecting to a server ("for access to the central computer database" in column 6, line 49 of Schwab); and (2) utilized for decoding an image (Schwab discloses, "Only a computer having this particular security key attached to the parallel interface connector of the PC is able to decrypt the image files and reconstruct the image" (column 6, lines 54-57)).

In short, Schwab discloses as follows:

- (1) correlation between a hardware key and connection to a server; and
- (2) correlation between a hardware key and password stored in a file.

However, (3) correlation between password stored in a file and connection to a server is not disclosed.

The reason why a password is contained in a file is to only decode the file, but not to connect to a server via that password in the file. As long as access with a server by using a password in a file is not disclosed by Schwab, Applicant emphasizes that the claimed "sharing attribute information" is not relevant to Schwab's password because the sharing attribute information is adopted to indicate "whether said image data... should be sent to said image management server," as recited in the claims. Accordingly, Schwab does not disclose sending a file

to a server according to a password (e.g., whether the password is exist or not) stored in the file, i.e., the password is not used to determine whether the file should be sent to the server.

As mentioned above, the Examiner concluded that, “this password information associated with individual images is analogous to the sharing attribute information recited in the claim.” Again, Schwab’s password and the claimed sharing attribute information are different from each other in that the claimed sharing attribute information is for determining whether to send image data to a server, whereas Schwab’s password is for decoding a file.

Therefore, Schwab does not disclose an image management system, an image management terminal, an image management method and a computer readable medium including all the limitations recited in claims 1, 12, 16 and 18.

Claims 4.

Applicant stresses that Schwab does not disclose an image management system including the limitation “in displaying a plurality of images simultaneously on a display screen, each image management terminal displays each of the plurality of images in a visually distinguishable manner to indicate which of said image management server or said image management terminals, image data corresponding to each image displayed is stored,” recited in claim 4. This limitation is originally recited in claim 5, though the language has been revised.

Schwab discloses, “This area may contain one or more images from a variety of sources” (column 8, lines 10-11). However, the reference does not disclose displaying “each of the plurality of images in a visually distinguishable manner to indicate...,” as recited in claim 4.

Therefore, Schwab does not disclose an image management system including all the limitations recited in claim 4.

Dependent claims 3, 6, 7, 20, 22 and 23.

A dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim.

Therefore, claims 3, 6, 7, 20, 22 and 23 are patentable because they respectively include all the limitations of independent claims 1, 4 and 12. The Examiner's additional comments with respect to those claims do not cure the argued fundamental deficiencies of Schwab.

In addition, Applicant separately submits patentability of claims 6 and 7. Claim 6 recites that "said image management terminals assigns a first color to the background area when image data corresponding to the image displayed is stored in said image management server, and assigns a second color to the background area when image data corresponding to the image displayed is stored in said image management terminals." Claim 7 also recites that "said image management terminals assigns a first pattern to the background area when image data corresponding to the image displayed is stored in said image management server, and assigns a second pattern to the background area when image data corresponding to the image displayed is stored in said image management terminals."

According to the above, when a plurality of images are simultaneously displayed, different colors or patterns are used depending on storing place of image data. This indicates that the images displayed by the claimed invention has visual information. When a plurality of images are displayed simultaneously, the system displays those images so that a user can recognize where corresponding image data is stored. Schwab is silent on the use of such visual information. Therefore, the reference does not disclose an image management system including all the limitations recited in claims 6 and 7.

With respect to claims 11 and 22, the Examiner asserted that Schwab discloses that the management information is key word information of image data, and that the claims require "at

least one” and the keyword information is the ones. In response, Applicant has deleted the recitation regarding the keyword information from the claims. Therefore, the reference does not disclose all the limitations recited in claims 11 and 22.

Based on the foregoing, there are the above-described differences between the claimed invention and Schwab. Therefore, it is submitted that Schwab does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. Applicant respectfully solicits withdrawal of the rejection of claims 1-7, 11-20, 22, and 23, and favorable consideration thereof.

Claims 8-10 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab in view of Nakabayashi et al.

In the statement of the rejection, the Examiner asserted that the claimed invention would have been obvious over the proposed combination of Schwab and Nakabayashi et al.

It is settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Based on this legal tenet, Applicant submits that the proposed combination does not teach or suggest an image management system including all the limitations recited in claims 8-10 and 21.

As discussed above, Schwab does not disclose all the limitations recited in claims 1 and 4 upon which claims 8-10 and 21 depend. Moreover, the secondary reference, Nakabayashi et al. is also silent on what is claimed in claims 1 and 4.

Accordingly, the proposed combination of Schwab and Nakabayashi et al. does not teach or suggest an image management system including all the limitations recited in claims 8-10 and 21

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within the meaning of 35 U.S.C. §103. Therefore, Applicant respectfully solicits withdrawal of the rejection of the claims and favorable consideration thereof.

Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 SAB:TT
Facsimile: 202.756.8087
Date: August 25, 2004

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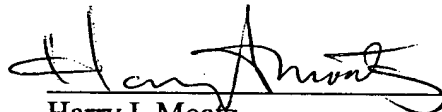
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Expires: June 1, 2006



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